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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,464	02/24/2004	Maurizio Tamburro	CM2601MC	8597

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EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,464

Applicant(s)

TAMBURRO ET AL.

Examiner

Jeremy R. Pierce

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on November 18, 2005 has been entered. Claims 1-6 and 10-12 have been amended. Claims 1-12 remain currently pending. The amendment is sufficient to overcome the 35 USC 112 2nd paragraph rejections set forth in section 4 of the last Office Action. The prior art rejections set forth in the last Office Action have not been overcome by the current amendment. However, modification of them is made in accordance with the newly claimed limitation.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the European Patent Office on August 24, 2001. It is noted, however, that applicant has not filed a certified copy of the European application as required by 35 U.S.C. 119(b). Although Applicant filed a certified copy of the European application with Application 10/785,277, the present Application does not have a parent/child relationship with that Application. Therefore, a separate certified copy is required for this Application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelkenberg (U.S. Patent No. 5,496,933) in view of Kellenberger et al. (U.S. Patent No. 4,699,823) and Sackmann et al. (U.S. Patent No. 5,635,569).

Kelkenberg teaches providing chitosan salts as powder in hygienic articles (column 4, lines 20-24). Kelkenberg teaches the particles may be water soluble (column 3, lines 35-47). Kelkenberg discloses that the particle sizes are much less than 1 mm (column 2, line 25) and that some particles are smaller than 1 micron (column 2, lines 26-27). Although the reference discloses using particles smaller than 1 micron, Kelkenberg does not specifically teach the average particle size to be less than 300 microns. Kelkenberg is also silent as to the structure of the hygienic article.

Kellenberger et al. teach a diaper material comprising a topsheet, backsheet, and absorbent core (See Figure 2). The absorbent core is hydrophilic (column 4, line 43) and also comprises superabsorbent powder (column 5, lines 9-23). The fibers of the core material would comprise the claimed "absorbent member." Kellenberger et al. teaches that the absorbent particles in the outer region of the core should have particles averaging less than 300 microns in size (column 6, lines 47-49). Sackmann et al. also teach that smaller particle sizes in superabsorbent materials allows for more rapid liquid intake (column 3, lines 44-48). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the Kelkenberg chitosan salt particles at the average size of 300 microns or less in a diaper structure taught by Kellenberger et

al. and to place those particles in the region adjacent the backsheet in order to provide a diaper with rapid intake towards the bottom of the core, as taught by both Kellenberger et al. and Sackmann et al.

Regarding the new limitation of a sprayed on layer of particles of chitosan material that spans across void spaces on or within the absorbent member, the structure of the absorbent particles within Kellenberger et al. appear to meet this limitation. The limitation that the particles are sprayed on is merely a process of making limitation in a product claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Kellenberger et al. teach the particles are distributed in a concentration gradient in the direction of the thickness of the batt (column 5, lines 38-41). Additionally, Kellenberger et al. also disclose that the particles are uniformly distributed across the length and width of the core material (column 5, lines 47-54). Thus, the particles would be present within the void spaces both on and within the fibrous batt and would also cover the fibers (i.e. constituents of the absorbent material).

With regard to claims 3, 4, 11, and 12, one can see about 100% of the back surface of the diaper in Kellenberger et al. is covered by regions of superabsorbent particles (Figures 2-4 and 6). With regard to claim 5, Kellenberger et al. show additional

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layers of tissue sheets may be added (column 4, lines 45-47). With regard to claim 7, Kelkenberg teaches only 20% of the chitin is acetylated (column 2, lines 46-48). With regard to claim 8, the chitosan can be mixed with lactic acid (column 4, line 16). With regard to claim 9, Kellenberger et al. teach the fibrous core batt is air-formed (column 4, lines 43-44). With regard to claim 10, Kellenberger et al. teach the superabsorbent should be present in an amount between 12 and 15% by weight of the batt. Thus, the claimed amount of 0.1 to 200 g/m² of superabsorbent particles would be met so long as a person of ordinary skill in the art used an absorbent core that weighed between 0.8 and 1,333 g/m². It would have been obvious to a person having ordinary skill in the art at the time of the invention to use between 0.1 to 200 g/m² of superabsorbent particles in the absorbent core of Kellenberger et al., since such range is so broad that practicing outside of it would make it impractical to actually produce an absorbent article.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,833,487 in view of Kellenberger et al. and Sackmann et al. The claims of the '487 Patent disclose an absorbent member containing chitosan salt particles. Although the claims are silent as to the size of the particles, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use chitosan salt particles at the size of 300 microns or less in the region adjacent the backsheet in order to provide a diaper with rapid intake towards the bottom of the core, as taught by both Kellenberger et al. and Sackmann et al. Also, it would be obvious to use particles between 10 and 800 nm in size because optimizing result effective variables involves only routine skill in the art, as set forth above.

7. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,867,287 in view of Kellenberger et al. and Sackmann et al. The claims of the '287 Patent disclose an absorbent member containing chitosan salt particles. Although the claims are silent as to the size of the particles, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use chitosan salt particles at the size of 300 microns or less in the region adjacent the backsheet in order to provide a diaper with rapid intake towards the bottom of the core, as taught by both Kellenberger et al. and Sackmann et al. Also, it would be obvious to use particles

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between 10 and 800 nm in size because optimizing result effective variables involves only routine skill in the art, as set forth above.

8. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No.

6,887,564 in view of Kellenberger et al. and Sackmann et al. The claims of the '564 Patent disclose an absorbent member containing chitosan salt particles. Although the claims are silent as to the size of the particles, it would have been obvious to a person having ordinary skill in the art at the time of the invention to use chitosan salt particles at the size of 300 microns or less in the region adjacent the backsheet in order to provide a diaper with rapid intake towards the bottom of the core, as taught by both Kellenberger et al. and Sackmann et al. Also, it would be obvious to use particles between 10 and 800 nm in size because optimizing result effective variables involves only routine skill in the art, as set forth above.

9. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/785,277. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '277 Application claims an absorbent member having chitosan salt particles with similar particle size ranges. Also, similar dependent claims are present.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-12 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/021,634. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '634 Application claims an absorbent member having chitosan salt particles with similar particle size ranges. Also, similar dependent claims are present.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. Applicant's arguments filed November 18, 2005 have been fully considered but they are not persuasive.

12. Applicant points out that Kelkenberg, Kellenberger et al., and Sackmann et al. all teach using powder. Applicant points out that the powder material from the references would rest in the void spaces within the absorbent member but would not have the structure of a layer that spans across the void spaces and partially covers the constituent materials of the absorbent member. However, this new limitation does not differentiate the claim from the prior art. If the powder rests within the spaces between the fibers of an absorbent core, it will also "span across void spaces within the absorbent member" because it would cover the area (i.e. void) between the fibers. Also, the particles "cover the constituents of the absorbent member" because the cover

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the fibers of the core batting. There does not appear to be differentiating language within claim 1 from the prior art.

13. Concerning the double patenting rejections, Applicant argues that Kellenberger et al. and Sackmann et al. fail to teach the newly claimed limitation in claim 1. However, the Examiner does not believe Kellenberger et al. to be deficient in this regard, as set forth above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571)

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272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP
Jeremy R. Pierce
January 12, 2006

Elizabeth M. Cole
ELIZABETH M. COLE
PRINCIPAL